REMARKS

The instant Office Action mailed October 27, 2004, set a three-month shortened statutory period for response expiring January 27, 2004. This amendment is therefore timely filed.

Claims 9, 11, 13, 14, and 16, which are directed to the non-elected subject matter of Groups II to IV, have been cancelled without prejudice to the filing of a continuation application on the same.

Claims 8 and 10 have been cancelled without prejudice to the filing of a continuation application on the same.

Claims 12 and 15 have been amended to change their dependency from cancelled claims 8 and 10 to claims 17 and 18, respectively.

Claim 17 has been amended in order to write this claim in independent form and to incorporate all of the limitations from now cancelled claim 8 (from which claim 17 originally depended).

Claims 8, 10, 12, 15, 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nador et al. (WO 91/08200), on the grounds that the instant compounds and compositions allegedly generically embrace the instant compound and compositions, i.e. the compounds of formula (I) wherein Ar^1 and Ar^2 represent substituted phenyl and R^1 and n are zero.

This rejection is traversed and reconsideration and withdrawal thereof are respectfully requested for the reasons given hereinbelow.

Without acquiescing in the propriety of the rejection, and solely to advance prosecution, Applicants have cancelled claims 8 and 10 and have amended claims 12 and 15 to depend from claims 17 and 18. Thus, insofar as it pertains to claims 8 and 10, the rejection under 35 U.S.C. § 103(a) is rendered moot.

As to the remaining claims, it is pointed out that Nador et al. disclose a broad group of compounds represented by formula (I) which contains a number of variables, including, for example, Ar^1 and Ar^2 which may be mono or polysubstituted by a selection of at least 15

substituents (i.e., halo, trifluoromethyl, hydroxy, C_1-C_6-alkyl and C_1-C_6-alkoxy). The compounds of the currently claimed invention, however, require significantly different substituents on the phenyl ring that corresponds to Nador's "Ar^1." Specifically, Applicants R'_2 variable is a substituent selected from a phenyl, phenoxy, phenylmethyl or phenylethyl group, which can be optionally further substituted. None of the Ar^1 substituents described by Nador et al. contain any aromatic groups, let alone any phenyl group, as required by the instantly claimed compounds. Therefore, none of the 15 possible Ar^1 substituents taught by Nador et al. are "homologs" of the phenyl-containing substituents of R'_2. Moreover, one skilled in the art would not be motivated to make any of the instantly claimed compounds because each possible R'_2 substituent contains an aromatic moiety, whereas none of the Nador substituents contain an aromatic moiety. This is an important difference, because aromatic ring system substituents have significantly different chemistry and sterics than non-aromatic substituents. The Examiner has simply provided no evidence why one skilled in the art would consider such compounds obvious in view of Nador et al. Hence, the rejection of claims 12, 15, 17, and 18 under 35 U.S.C. §103(a) based on Nador et al. is believed to be unwarranted and should be withdrawn

Claims 8, 10, 12, 15, 17, and 18 (only claims 12, 15, 17, and 18 of which remain in the application) are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nador et al. in view of U.S. Patent No. 5,512,584, issued to Steiner et al. for the stated reason that Nador et al. teach analogous compounds having pharmaceutical uses which are purported to be homologs of the instantly claimed compounds, and Steiner et al. are relied upon for allegedly teaching that the variation in the methylene adjacent to the ring retains activity.

This rejection is respectfully traversed and reconsideration and withdrawal thereof are respectfully requested for the reasons given hereinbelow.

Nador et al. disclose a compound of formula (I), which, due to a number of different variables, represents a broad group of compounds. However, all of the compounds actually exemplified by Nador et al. are tetrahydropyridylethyl ketones. Applicants' claimed compounds, on the other hand, are all tetrahydropyridylmethyl ketones. Thus, the Nador et al. reference

considered as a whole for what it fairly teaches one skilled in the art would not have suggested Applicants' claimed compounds, all of which are tetrahydropyridylmethyl ketones.

Recognizing this deficiency of the primary Nador et al. reference, the Examiner relies on the secondary Steiner et al. reference as purportedly teaching that variation in the methylene adjacent the ring retains pharmaceutical activity. However, all of the piperidinylalkyl ketones disclosed by Steiner et al. are piperidinylpropyl ketones. Clearly then, nothing in Steiner et al. would suggest modifying the tetrahydropyridylethyl ketones of Nador et al. to arrive at Applicants' tetrahydropyridylmethyl ketones. Furthermore, Applicants again note that each of the instantly claimed compounds require a phenyl-containing substituent on the phenyl group that corresponds to Nador's Ar^1, whereas none of Nador's possible Ar^1 substituents contain a phenyl radical or any other aromatic moiety for that matter. Steiner et al. add nothing to these fundamental deficiencies in the Nador et al. reference. Accordingly, Steiner et al. and Nador et al., taken either individually or in combination, are incompetent to teach or suggest Applicants' claimed compounds. Therefore, the rejection of claims 12, 15, 17, and 18 under 35 U.S.C. §103(a) based on said references is believed to be unwarranted and should be withdrawn

Claims 12 and 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention on the grounds that the term "containing" in claims 12 and 15 is open ended because it allows for the inclusion of other active agents.

This rejection is traversed and reconsideration and withdrawal thereof are respectfully requested for the reasons given hereinbelow.

Applicants agree with the Examiner that the transitional phrase "containing" is open-ended and does not exclude additional, unrecited elements or methods steps. However, the use of an open-ended transitional phrase does not render the instant claims indefinite.

The rejected claims require both a pharmaceutical composition that contains a compound of the invention together with a pharmaceutically acceptable vehicle or diluent. The Examiner maintains that these claims allow for the inclusion of other active ingredients, and that Applicants should not have limitations of the specification read into the claims. Yet, the

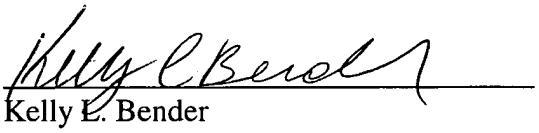
Examiner does not explain why this limitation, which is not expressed in the claims, has been or should be read into the claims.

The absence of a limitation, specifically that the claims do not exclude other active agents, does not render claims indefinite because the absence of a limitation has a precise meaning. Breadth is not indefiniteness. Furthermore, the patent literature is replete with examples of granted U.S. patents in which open-ended transitional phrases are used in pharmaceutical composition claims and, hence, have been found to comply with the provisions of 35 U.S.C. § 112, second paragraph, by the United States Patent and Trademark Office. Accordingly, Applicants submit that the instant pharmaceutical composition claims do indeed comply with the requirements of 35 U.S.C. § 112, second paragraph, and that the rejection of these claims on this basis should, therefore, be withdrawn.

There being no remaining issues, this application is believed in condition for favorable reconsideration and early allowance, and such actions are earnestly solicited.

Respectfully submitted,

Date: 1/25/05



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